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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/797,373
Filing Date: March 09, 2004
Appellant(s): LEAS ET AL.

Allan A. Fanucci
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 13, 2009 appealing from the Office action mailed April 29, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

In summary, the status of the claims is as follows:

Claims 1-4, 8-10 and 25-37 are rejected.

Claims 5-7, 11-24 are cancelled.

Claims 1-4, 8-10 and 25-37 are being appealed.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

In summary, no amendments were filed after the final Office Action, mailed April 29, 2008. A request for reconsideration, however, was filed on October 21, 2008, which was considered but not found to be convincing.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

It is noted however that the obviousness-type double patenting rejections are withdrawn in view of the abandonment of the copending Applications 10/294764, 10/685177 and 10/800222, which the double patenting rejections had relied on.

Claims 1-4, 8-10 and 25-33 were also rejected under obviousness -type double patenting rejection over claims 1-3 and 7-14 of copending Application No. 10/984914, however, since claims 1-3 and 7-14 of copending Application No. 10/984914 have been cancelled, the obviousness-type double patenting rejections have been withdrawn.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2,106,893	Krein	2-1938
EP 0276333 A1	D'Amato	8-1988
EP 0848910 A2	Kuehl et al.	6-1998
US 4778683	Newsteder	10-1988

US 20030099746 A1	Palmer et al.	5-2003
US 5035907	Phillips et al.	7-1991

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4,8,10 25-28, and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krein (US 2106893) in view of Damato (EP 0276333) and Kuehl et al. (EP 0848910 A2).

Regarding claims 1, 25 and 34, Krein teaches an open-ended shell made of a solid, fat-based composition and having a shell wall that defines an interior volume for holding at least a portion of an ice confection therein (Figure 10). The shell is a liquefied fat based composition that solidifies when cooled. As can be seen from figure 10, the end result is a shell wall in surface to surface contact with the packaging sleeve. It is noted that it would have been obvious to one having ordinary skill in the art that the shell would inherently have had a smooth outer surface, since the shell forming composition is applied as a liquid to a packaging material (i.e. the packaging sleeve), such as waxed paper and then hardened (page 1, left column, lines 31-38 and page 2, left column lines 7-11 and 22-27 and line 71 to page 2, right column, line 14). The packaging sleeve (Figure 10, Item 6) protects all of the outer surface of the shell (Figure 10, Item 60) with the packaging sleeve formed in a shape that corresponds to the desired shape that one wishes to impart to the outer surface of the shell and having an

inner surface that is in contact with the outer surface of the shell. A frozen confection is in the interior volume of the shell (Figure 10, Item 65).

The claims differ from the Krein in reciting wherein the entire packaging sleeve is transparent; Krein disclosing waxed paper as the packaging sleeve.

Damato teaches using transparent plastic foil (Page 3 of 6 and Page 5 of 6) for frozen confections having a conical shape (Figure 3, Item 11). Damato further teaches that the use of transparent packaging results in a more consumer friendly packaging. That is, the consumer can freely view the ice-cream in the packaging and does not need to be distracted by advertisement on the exterior of the container. Further the consumer would not have to solely rely on a photograph of the ice cream contained therein and can directly determine whether to purchase and consume the ice cream (See Page 2 of 6). Krein teaches forming a two-tone color to the edible product, that results in a highly attractive color effect (Page 1, Column 2, Lines 46-53) when the wrapper is removed. Nevertheless, it would have been obvious to one having ordinary skill in the art, based on the teachings of Damato, to use a transparent material for packaging the confection of Krein for the purpose of improving the marketability of the product. Since the two-tone effect can be highly appealing to the consumer, it would have been obvious to the ordinarily skilled artisan that using a transparent packaging would have resulted in the consumer further viewing the attractive color effect prior to purchasing. As a result the consumer would have been able to accurately inspect the product while also being further drawn to the product as a result of the color effect applied by Krein. Additionally, using the transparent plastic packaging of Damato also provides the further benefit of a

liquid tight package for good protection during sale and eating with improved handling due to an intended break line.

The claims further differ from the combination in reciting a decorative edible pattern design forming a smooth surface of the outer wall of the shell, said pattern design comprising strings of a first semi-solid confection material that form a mesh of strings and a second confection material of a contrasting color to that of the first confection material located between the strings.

Similar to Krein, Kuehl et al. teach molded chocolate shells intended for holding ice cream. Kuehl et al. further teach that the shells include different colored layers that offer the advantage of providing attractive marbled appearance without losing adherence between the layers. The ingredients may be fat based, provide a first layer of strings and a second layer of a different color (e.g. white and plain chocolate) for the purpose of visual effects, which would result in shiny appearances. Furthermore, Kuehl et al. teach applying forced air onto the surface of the strings or dragging a probe across the surface of the strings (Page 2, Lines 10-55, Page 3, lines 3-56, Page 4, lines 4-10, Example 1), thus resulting in a smooth surface. Since Kuehl et al. teach that the coating compositions are liquid when applied and then cooled, using forced air and vibration (to remove air bubbles), would have resulted in the smoothing of the liquid. Thus, there would have been a reasonable expectation of smoothing in the product of Kuehl et al. Kuehl et al. also teach that the visual effect can be formed as a result of the first coating being sprayed, similar to Krein and the second layer being spun onto the first coating layer. Similar to Kuehl et al., Krein also teaches providing a distinctive

appearance to the product as a result of the two-tone color effect (Page 1, Column 2, Lines 46-53). Additionally, the combination of Krein and D'Amato teach using transparent packaging for the purpose of allowing the consumer to view the product disclosed therein. The two tone color effect would have resulted in additional appeal for the product. Thus, it would have been obvious to the ordinarily skilled artisan to include a decoration in the chocolate cone wherein a first layer of strings is supplied in white chocolate, pressed/flattened by air or a probe, a second layer of plane chocolate is applied that is shiny as taught by Kuehl et al. and as recited in instant claims 1-3, 9, 10 and 28 that maintains good definition as recited in instant claim 4, since the combination of Krein and D'Amato teach providing attractive product in a transparent package for the purpose of consumer appeal. As such, Kuehl et al. teach that the chocolate shells provide an attractive appearance with interesting visual effects when they include a pattern design comprising a first layer of string lines made of white chocolate that are pressed or flattened via air or probes, a second layer of plain chocolate (i.e. a contrasting color), as recited in claims 1, 2, 9, 10, 28, 36 and 37, wherein the different colored layers do not separate or are capable of maintaining the pattern, as recited in instant claim 4 and that form a shell similar to Applicant that results in a shiny appearance, as recited in instant claim 3. Thus, it would have been obvious to the skilled artisan that application of such visual effects to the shell of modified Krein would have resulted in a product having interesting visual effects that the consumer would have been able to directly view, thus providing further appeal to the consumer.

Claims 32 and 33 differ from Krein in explicitly reciting wherein the package is completed by the addition of a lid which may be transparent and which further comprises printed material on the sleeve or lid.

D'Amato teaches wherein the lid and the container are comprised of the same transparent plastic foil material (Page 5 of 6) and as discussed above, teach that the transparency allows the user to accurately view the product disclosed therein instead of potentially inaccurate pictures. Based on this teaching it would have been obvious to include a lid for protecting the food product while also allowing complete viewing of the food product by the consumer. Providing a lid also would have protected the top of the product from damage during shipping and handling. Regarding instant claim 33, Damato teaches providing advertisements on the transparent packaging (Figure 3 and Page 5 of 6). As such, the addition of packaging adornments on the transparent packaging would have been obvious to one having ordinary skill in the art for the purpose of providing a mercantile package with information regarding the product, such as appealing designs or nutrition information.

Claim 31 differs from Krein in reciting that the shell further comprises other inclusions such as nuts, chocolate chips, sugar confectionery particles, preserved fruit, mint chips, or biscuit crumbles. However, Kuehl et al. teach wherein the coating can comprise praline (Page 3, Lines 3-5), which is well known to the ordinarily skilled artisan to be candy patties comprising nuts. Thus, Kuehl et al. teach a coating comprising nuts as inclusions. As such it would have been obvious to use a coating that comprises inclusions, such as nuts, as taught by Kuehl et al. for the purpose of providing other

distinctive flavored products that appeal to the varying consumers' tastes. Even further, Selbak (US 5425527) is relied on as further evidence of cones that contain inclusions (Column 2, Lines 56-61), depending on the particular recipe for the cone.

Claims 9, 29 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krein (US 2106893) in view of Damato (EP 0276333) and Kuehl et al. (EP 0848910 A2) and in further view of Newsteder (US 4778683), Palmer (US 20030099746 A1), and Philips et al. (US 5035907).

Claims 9, 29, 34 and 36 differ from the combination of Krein, Damato and Kuehl et al. in reciting the limitation of the decorative pattern including writing, script, a logo or a symbol. Although Kuehl et al. teach that the design can include patterns or appearances such as marbled, mottled, hued, variegated, dappled, etc..., it is noted that Newsteder, Palmer and Philips et al. have been further relied on to teach that it has been conventional in the art to use another edible composition for the purpose of printing writing or symbols onto a confection. Therefore, although Krein modified by Damato and Kuehl et al. does not specifically recite that the pattern includes writing, script, a logo or a symbol, the prior art teaches that it has been conventional to use symbols, logo or writing to impart a design onto a food product. It is further noted however, that since Kuehl et al. teach decorative patterns, that to specifically change that pattern into a particular shape, such as a logo or writing, would not have provided a patentable feature over the prior art since the art already teaches that it has been conventional to make patterns into the shell of a frozen confection. Once it was known

to provide a product with a pattern or design, to employ a pattern or design that conveys a message or symbol, i.e. a pattern or design in the form of writing or a logo, would have been an obvious matter of choice and/or design, especially since it was, of course, well established to impart writing or logos on products as evidenced by the prior art.

(10) Response to Argument

On page 12 of the Appeal Brief, regarding the provisional obviousness type double patenting rejections, Appellant urges that the copending Application No. 10/294764 has not been allowed and accordingly this rejection should be reversed or at least deferred until a later time. Appellant makes a similar argument on page 13 of the Appeal Brief in view of the other double patenting rejections.

It is noted that these urgings are moot in view of the fact that, as noted above, the double patenting rejections have been withdrawn as a result of the abandonment of the copending Application Nos. 10/294764, 10/685177 and 10/800222 and the cancellation of claims 1-3 and 7-14 in copending Application No. 10/984914.

On pages 14-15 of the Appeal Brief, Appellants urge that,

“Specifically, the Examiner failed to establish proper bases for the obviousness rejections because there is: (1) no motivation to combine the references, and (2) no suggestion of the claimed invention in the references themselves. To establish an obviousness rejection, there must be a showing that there is a motivation to combine the prior art and that the combination of the prior art teaches or suggests each and every element of the claimed invention. Lack of motivation or suggestion demonstrates the patentability of the claims over the cited references. Without such motivation or suggestion, the rejection is improper and should be reversed for that reason alone.”

The Examiner has also failed to consider each prior art reference for its teachings as a whole, including portions that would lead away from the claimed invention. Additionally, the Examiner has engaged in impermissible hindsight reasoning in arriving at the above-detailed obviousness rejections, because the cited references lack both express and inherent motivation for one skilled in the art to combine the references in the manner proposed, to result in the presently claimed invention.

Nevertheless, if references are to be combined, there needs to be a motivation found in the art to make the combination in the manner alleged. Neither the suggestion nor the motivation can be based on the teachings of appellants' disclosure. In the present instance, the Examiner has failed to cite a motivation to combine the above-mentioned references in a manner to teach that which is claimed. There is a clear lack of a motivation in the cited references for one skilled in the art to combine the references. The alleged nexus of similar ice confection products in the references is insufficient to render the present claims obvious, since each reference is not directed at applicants' invention but instead are directed at different features that are not relevant to the present claims. Furthermore, a skilled artisan having all of that prior art information before him or her is still not motivated to obtain the presently claimed invention, and the fact that none of the references even mention the possibility of forming products such as those that are presently claimed support instead a finding that the claims are not obvious."

As stated in the final rejection, mailed April 9, 2008, it is noted that the motivation to combine the references need not lie in the primary reference. In this case, the primary reference to Krein teaches an open-ended shell made of a solid fat based composition and having a shell wall that defines an interior volume for holding at least a portion of an ice confection and having a smooth outer surface. It is noted it would have been obvious that the outer surface would inherently have been smooth, since the composition is applied in liquid form and thus coats the inner walls of the packaging. Krein is silent in employing a transparent packaging sleeve. Nevertheless, D'Amato has been relied on to teach that if one desired to directly view the contents within the

package, as opposed to a printed design depicting the contents, then it would have been obvious and advantageous to employ a conventional transparent material. It is further noted that transparent packaging has been well established in the art to be used for the purpose of viewing the contents within the packaging. Krein provides the added teaching that the ice cream confection has "a highly attractive," two tone color effect (page 1, right column, lines 46-53). Since the product taught by Krein is highly attractive, this provides further motivation to employ transparent packaging in order to view this highly attractive product. The combination of Krein and D'Amato teaches the use of transparent packaging for viewing the actual ice cream confection, as opposed to a depiction of the product. The claim still differs from this combination in reciting a decorative pattern design comprising strings of a first semi-solid confection material that forms a mesh of strings and a second confection of contrasting color to that of the first confection. In this case, the previously applied combination already teaches that it would have been advantageous to employ transparent packaging. Kuehl has thus been relied on to teach a fat based composition that forms a hardened shell, which comprises a decorative pattern comprised of a first semi-solid confection material and a second confection material, for the purpose of providing an appealing "marbled appearance" to the fat based shell. To therefore modify the combination and employ a marbled appearance to the fat based shell would have been obvious to one having ordinary skill in the art, as taught by Kuehl, for the purpose of providing an added aesthetic appearance to the fat based shell of the ice cream confection. Therefore, appellant's arguments are not persuasive.

On page 15-16 of the Appeal Brief, Appellant urges that,

"Krein expressly states that a 'very highly desirable, if not essential,' consideration in choosing material for the wrapper is that the wrapper be 'of such economical material as to be destroyed and discarded at the time it is desired to eat the confection.'" Therefore, appellant urges that "from Krein's disclosure, that Krein was primarily interested in providing an efficient and economic method of making a frozen confectionary product with a chocolate coating and a temporary wrapper."

These arguments have been carefully considered but are not deemed persuasive. The rejection is based on the art taken as a whole at the time of appellants' invention (i.e. the effective filing date of this application). Regarding the disclosure by Krein of using "economical material," it is noted that the material employed by Krein might have been more economical at the time of Krein's invention. However, the particular economical value of a material at the time of Appellants' invention, would have been an obvious result effective variable. The term "economical material" is also a broad term that varies depending on the particular manufacturer's preferences, appropriate funds and method of manufacture to name a few. Regarding the phrase "of such economical material as to be destroyed and discarded at the time it is desired to eat the confection" it is noted that any packaging material that is to be removed, in order to consume the food product placed therein, can be considered economical so as to be destroyed and discarded at the time it is desired to eat the confection." Most packaging material for foods is "destroyed and discarded" to some degree.

Even if appellant's urging that economical packaging was Krein's primary interest, this does not exclude that other interests were also present.

Regarding the urging that there is no motivation to combine the references, it is noted that D'Amato has been relied on to teach the conventionality of using transparent plastic for the purpose of forgoing the need for packaging that would have additional pictures or drawings for showing the consumer what the food contained therein looks like. Furthermore, it is noted that D'Amato further teaches solving the problem of viewing the contents within the package, by using a transparent packaging. If one did not want to use printed indicia, so as to make the packaging more economical, it would have been obvious to have used transparent packaging so that the consumer can directly view the product. It would further have been obvious to use transparent packaging, since Kuehl teaches producing a product with an attractive two-tone appearance. Therefore, instead of using a printed picture of the design on the packaging, the transparent packaging of Damato would have allowed the consumer to directly view the design.

Even if it could have been assumed that Krein's primary interest was in providing an efficient and economic method of making a frozen confectionary product with a chocolate coating and a temporary wrapper, it is noted that Krein nonetheless recognized, as would most, that a "highly attractive" product is a desirable product. Therefore, the appearance of the product, to some degree, was a consideration in making the product. Thus, it can be seen that there is motivation in the reference to Krein for providing transparent packaging, so that the highly attractive appearance of Krein's product can be view through the packaging. To therefore employ a transparent packaging material would therefore have been obvious, for the purpose of directly

viewing the product. It is noted that Appellant urges that the transparent packaging sleeve "enables the consumer to view the product and be incentivised to purchase it due to its interesting appearance. Nevertheless, it is noted that the particular purpose of the transparent packaging still is the same as that taught by the art: to enable the consumer to directly view the contents within the transparent packaging. Krein might be silent as to the transparency of the package but still recognized that the appearance of the product is pleasing. As discussed above, the secondary reference to D'Amato teaches solving the problem of viewing the frozen ice cream cone contents within the package by employing transparent packaging.

On page 16 of the Appeal Brief, Appellant urges that,

"D'Amato also appears to teach advertising on the transparent material."

It is noted that Figure 3 of D'Amato shows the transparent packaging and the written words shown in the figure (item 15) are inside of the transparent packaging (11).

On pages 16-17 of the Appeal Brief, Appellant urges that,

"D'Amato's ice confection is prepared outside the packaging, and thereafter placed in the packaging, such that there can be no complete surface-to-surface contact between the ice confection and the packaging," and further urges that "there also would not be a smooth exterior surface of the shell, since there is no disclosure in D'Amato as to how to form such a smooth surface cone."

It is first noted that appellants' claims are directed to the product and as such, the patentability of a product, as claimed, cannot be predicated on the particular method by

which the product was made. For instance, depending on the particular tolerances, a chocolate confection shell could be pre-made and dropped into a transparent packaging which included complete surface to surface contact. In any case, it is noted that D'Amato has not been relied on to teach complete surface to surface contact or a smooth exterior surface of the shell since this is already disclosed by Krein. D'Amato, rather, has been relied on to teach the advantages of providing transparent packaging for an ice confection, as discussed above, for viewing the contents as opposed to a printed image of the contents.

Further on page 17 of the Appeal Brief, Appellant urges that

"The provision of the outer surface of the shell in contact with the sleeve provides unexpected results. As previously noted, this enables the consumer to view the product that they are intending to purchase and consume."

This argument is not persuasive for the reasons discussed above with respect to Krein and D'Amato. Therefore, the use of an outer surface of the shell in contact with the sleeve is not unexpected since Krein teaches this structure. D'Amato teaches the advantages of transparent packaging, for being able to view the product. It is noted that this is also appellants' purpose of employing transparent packaging.

Further on page 17 of the Appeal Brief, Appellant urges that

"And the smooth outer surface of the shell, while attractive in its own right, includes a decorative pattern design which forms part of the smooth outer surface of the shell, thus providing further attractiveness and desirability to the appearance of the product. This is because the pattern design comprises strings of a first semi-solid

confection material that form a mesh of strings and a second confection material of a contrasting color to that of the first confection material located between the strings. The strings can be arranged to form patterns of shapes or words to provide unique appearances to the products, thus facilitating acceptance and sales by consumers. In contrast, D'Amato includes open space between his sleeve and product which diminished the impact of the appearance of the product. Furthermore, even when a plastic container is used, D'Amato preferably places his ice confections in cardboard sleeves which contains advertisements, labels or pictures, which may be viewable through the plastic container, relying upon the advertising, rather than the product itself, to encourage sales. See D'Amato Fig. 3."

It is noted that D'Amato has not been relied on to teach strings of patterns of shapes or words to provide unique appearances to the products. D'Amato has only been relied on to teach the advantages of transparent packaging for similar types of ice confections. For the use of employing a first semi-solid confection material that forms a mesh of strings and a second confection material of contrasting color to that of the first confection material, for the purpose of providing unique appearances to the products, the reference to Kuehl has been relied on.

Appellants urge that D'Amato prefers to place his ice confections in cardboard sleeves which contain advertisements, labels or pictures which may be viewable through the plastic container and relying on the advertising rather than the product itself. It is noted that D'Amato teaches that the transparent packaging allows for the consumer to view the product as opposed to viewing a printed image of the product, as discussed above. Whether one placed a cardboard sleeve inside the transparent packaging but over the ice cream cone does not obscure the fact that D'Amato teaches transparent packaging for cone shape ice confections for directly viewing the product, as opposed to

viewing a printed image of the product on the outside packaging. Therefore, appellants' argument is not persuasive.

On page 18 of the Appeal Brief, Appellants urge that,

"Kuehl does not disclose a packaging sleeve for wrapping the bars, and either places strips of chocolate in a production mold, or applies chocolate strips or dots upon ice confections shaped as bars. *Id.* Neither of these embodiments relate to a chocolate shell in complete surface-to-surface contact with a transparent packaging sleeve. *Id.*"

This urging has been considered but is not deemed persuasive. It is noted that Kuehl is similar to Krein in that both are employing a fat based confection shell to wrap an internal ice confection, such as ice cream. Kuehl has therefore, been relied on to teach that it has been conventional in the art to employ designs on the fat based shell by employing a first semi-solid fat based confection applied to form a mesh of strings and a second confection material of contrasting color to that of the first confection, for the purpose of providing a particular appearance to the fat based confection shell. It is noted that the claims are directed to a product and not the method of making the product. Therefore, the art teaches that it was conventional to employ more than one fat based composition to form a shell for an ice confection, wherein the multiple fat based compositions result in a design formed on the shell, such a marbled appearance. To therefore modify the combination and employ an additional fat based composition that is applied for form strings would have been obvious to one having ordinary skill in the art, for the purpose of providing a desired appearance to the fat based shell. Since Krein already recognized and achieved a product that has a "highly attractive" appearance, this provides additional motivation to employ another fat composition into

the shell that achieves a marbled appearance for making the product even more attractive.

Further on page 18 of the Appeal Brief, Appellants urge that,

"The maintenance of a smooth outer surface is not of significance or concern to Kuehl, who instead focuses on providing a visually interesting product having different colors or surface contours. Leas Declaration, paras. 7 and 15. Kuehl further does not utilize a sleeve that conforms to the outer surface of the confection. Leas Declaration, para. 15."

These arguments have been considered but are not deemed persuasive. It is noted that Kuehl has not been relied on for teaching a sleeve that conforms to the outer surface of the confection. This has already been taught by Krein. Krein also teaches a "highly attractive" product. Kuehl has been relied on to teach that it was conventional in the art to improve the appearance of a fat based composition that forms a shell which contains an ice cream, for instance, by employing multiple types of fat compositions for providing a marbled appearance. Regarding maintenance of a smooth outer surface, it is noted that both the first and second fat based compositions used to make the fat based shell with the strings that created the marbled appearance are both applied to a mold prior to any solidification taking place (see page 3, lines 15-17), and then filled with ice cream. Since the fat based composition has been applied into molds before any solidification takes place, it would have been obvious that the side in contact with the mold would have taken the shape of the mold and therefore would have had a smooth outer surface since the liquid would have conformed to the shape of the mold. Regarding the packaging, it is again noted, that Krein has been relied on for this

teaching. In any case, it is noted that Kuehl teaches that "preferably, the container has a shape that closely follows the contour and volume of the confectionery or ice cream product" (Page 3, lines 35-36).

Further on page 18 of the Appeal Brief, Appellants urge that,

"Finally, Kuehl's confectionary product is prefabricated prior to being placed in its packaging. In contrast, the product of the present invention has a smooth outer surface and a sleeve which is formed in a shape that corresponds to the desired shape of the shell, and which is in complete surface-to- surface contact with the shell. Leas Declaration, paragraph 15. Even if Kuehl's disclosure is combined with that of Krein and D'Amato, therefore, a skilled artisan cannot obtain the presently claimed invention."

These arguments have been considered but are not deemed persuasive. It is noted that appellants' claims are directed to a product and not the method of making the product. Therefore, another method for making the product could be employed for achieving appellants' claimed product.

On pages 18-19 of the Appeal Brief, Appellants urge that,

"Simply because both Krein and D'Amato generally disclose ice confectionary products, does not mean that unrelated portions of the disclosures of each reference may be combined with hindsight reconstruction, using Appellants' specification as a guide, to render the presently claimed invention obvious." While Krein is concerned with providing an economical means for making a frozen confection, D'Amato focuses on providing a durable container in which ice confections may be transported and handled without damage. One of skill in the art would not be motivated to combine the divergent teachings of these two references, because the disclosures of the two references are unambiguously directed at solving very different problems."

This argument has been considered but is not deemed persuasive. It is noted that the product of both Krein and D'Amato would have been transported and handled, since both are marketed, packaged ice cream products and use conventional materials of construction for the packaging materials for the ice cream products. Therefore the two references are not considered to be unrelated.

On page 19 of the Appeal Brief, Appellants urge that,

Further, portions of Krein clearly teach away from combination with D'Amato, as such combination would defeat the central purpose of Krein's invention.

While the Examiner notes that Krein "does not need to be relied on for addressing the problem of viewing the decoration on the food product" the Examiner improperly concludes that Krein provides "motivation to the ordinarily skilled artisan since the ice cream has a pleasing two-tone appearance." Despite the unambiguous disclosure of Krein, and the specific citations provided by Appellants above, the Examiner insists that Krein "is concerned with the appearance of the ice cream since he teaches that as the wrapping is removed the consumer would see a two-tone and highly attractive color effect." Accordingly, the Examiner concludes that "Krein does provide motivation to the ordinarily skilled artisan since the ice cream has a pleasing ...appearance."

These arguments have been considered but are not deemed persuasive. It is noted that D'Amato already provides the motivation and solves the problem of how to market an ice cream product without having to use printed images to depict the product within the package - use transparent packaging. Krein simply provides further motivation for employing transparent packaging by indicating that his product is "highly attractive." Based on D'Amato's teachings it would have been obvious employ transparent packaging when making the ice cream of Krein for the purpose of viewing the "highly attractive" product even before removing the packaging.

Further on page 19 of the Appeal Brief, Appellants urge that,

"However, as previously explained, Krein's mere recognition of the attractive appearance of his product, which is only viewable after the consumer has stripped away the wrapper, does not constitute motivation for a person of ordinary skill in the art to combine with D'Amato. Indeed, if the appearance of the confectionary product were truly of concern to Krein, he would have chosen a transparent packaging material, such that the consumer could view the product therein, before stripping away the wrapper. Transparent packaging wrappers were known and available at the time of Krein's disclosure, but Krein chose to use an opaque paper wrapper, as Krein's concerns centered around feasibility of manufacture and ease of removal of the wrapper."

This argument has been considered but is not deemed persuasive. Appellants urging of what Krein might have done and why Krein did not employ a particular type of packaging is Appellants' opinion and is not supported by any convincing evidence. It is noted that in view of the art taken as a whole, the claimed product would have been obvious to one having ordinary skill in the art at the time of appellants' invention, for the reasons given above.

On page 20 of the Appeal Brief, Appellants urge that,

"It is clear front Krein's disclosure and his choice of an opaque packaging material, that Krein's integral concern was to provide an economical wrapper, and not to allow the consumer to view the product through the wrapper. Accordingly, there would be no advantage in including a decorative pattern design on the shell of Krein, since the consumer would only see the wrapper, and not any pattern on the shell. *See* Leas Declaration, para. 19. Krein's mere acknowledgement of the visual appearance of his product, which would only be viewable upon removal of the packaging wrapper and immediately prior to consumption does not provide motivation for use of transparent packaging, as disclosed by D'Amato. And even where D'Amato uses a transparent container, he provides an opaque paper insert that includes advertising or other indicia thereon so that the consumer views the advertising rather than the product. This certainly does not demonstrate that D'Amato was concerned with providing the visibility

of his products through the packaging. Thus, like Krein, this is not a concern of his disclosure and a skilled artisan would not be taught to do what applicants have done even with a full understanding of Krein and D'Amato."

These arguments have been considered but are not persuasive. It is noted that in light of the teachings of D'Amato, who teaches that transparent packaging would allow one to view the actual product, it would have been obvious to one having ordinary skill in the art to employ transparent packaging as the packaging for the product of Krein for the purpose of being able to view the product through the packaging. It is noted that the disclosure by Krein that the product is highly attractive only provides further support for the advantages of employing transparent packaging. Regarding Appellants' urging regarding D'Amato using a paper insert so that the consumer views advertising rather than the product, it is noted that D'Amato still teaches using transparent packaging to view the contents. Regarding the use of an advertising sleeve *within* the transparent packaging, it is noted that if the ordinarily skilled artisan did not require a particular advertising sleeve, to exclude such a sleeve would have been an obvious matter of choice and/or design. This does not obscure the fact that D'Amato teaches transparent packaging to view the contents. It is noted that D'Amato also indicated that the purpose of the transparent packaging is to be able to view the ice cream product within the packaging. Therefore appellants' arguments are not persuasive.

Further on page 20 of the Appeal Brief, Appellants urge that,

"The Examiner has failed to properly explain how Krein's choice to use opaque packaging for his cone (especially when transparent packaging options were available),

may properly be reconciled with the Examiner's assertion that Krein provides motivation for allowing consumers to view the confectionary product through its packaging. Although Krein's product may exhibit a two-tone effect upon stripping away the wrapper, Krein does not provide motivation for employing transparent packaging, as set forth by the Examiner, in part because any modification of Krein's cone by adding D'Amato's more expensive packaging would defeat the central purpose of Krein's invention, which is to provide an economical packaging for housing a confection which is intended to be stripped away prior to consumption. This is especially true, as explained above, in light of the express disclosure in Krein, stating that a "very highly desirable, if not essential," consideration in choosing material for the wrapper is that the wrapper be of 'such economical material as to be destroyed and discarded at the time it is desired to eat the confection'

Appellants' arguments have been considered but are not deemed persuasive. As discussed above D'Amato provides the motivation for employing transparent packaging. The "highly attractive" product taught by Krein was only relied on as further support for the advantages of transparent packaging. It is further noted that whether D'Amato's packaging was more expensive (and how much more expensive) would not defeat Krein's central purpose of providing economical packaging since it is speculative that transparent packaging is not economical. Being economical and being inexpensive are not one in the same, since a material that is economical does not have to be cheap, and a material that is cheap is not necessarily economical. Furthermore, the condition disclosed by Krein for what could be considered economical is that it should be destroyed and discarded at the time it is desired to eat the confection. As discussed above, most food packaging for pre-packaged food products is destroyed and discarded at the time it is desired to eat the confection. Therefore Appellants arguments are not persuasive.

On page 21 of the Appeal Brief, Appellants urge that,

"the economic considerations previously highlighted and also as explained above, are relevant and instructive in demonstrating the central purpose of Krein's invention, which was to provide an economical packaging for confectionary. Accordingly, the considerations appropriately taken into account would be those prevalent at the time of Krein's invention, and not at the time of Appellants' invention. Notably, the Examiner has failed as yet to provide an appropriate justification as to how Krein's disclosure may be reconciled and combined with D'Amato, allowing for Krein's cone to be wrapped in transparent packaging which is more expensive than paper, when Krein's disclosure is replete with concerns regarding minimizing production costs."

This argument has been considered but is not deemed persuasive. It is noted that whether the invention would have been obvious, in view of the art taken as a whole, would have been at the time of appellant's invention and not of Krein's invention, which was made approximately 66 years prior to Appellants' invention, especially the claims are directed to a product and not a method of making the product and even further since the reference to D'Amato teaches the advantages of transparent packaging while being silent as to any drawbacks due to expense.

Further on page 21 of the Appeal Brief, Appellants urge that,

"Under the decision by the Court of Appeals for the Federal Circuit in KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727 (2007), there must be a reason for a person of ordinary skill in the art to combine the elements claimed in order for there to exist a finding of obviousness. As set forth above, there is no reason to combine the teachings of the references as suggested by the Examiner so that the obviousness rejection should be reversed."

In view of the art taken as a whole, the reason for providing transparent packaging is to allow the consumer to view the product, instead of a printed image depicting the product.

On page 22 of the Appeal Brief, Appellants urge that,

"maintenance of a smooth outer surface is not of concern to Kuehl, and is merely incidental to Kuehl's products. While Krein discloses a shell which is in complete surface-to-surface contact with its packaging, Kuehl does not as he utilizes a production mold for this purpose. Thus, there is no motivation to combine Krein and Kuehl for the reasons enumerated above, and further because Krein is not interested in the visual appearance of his product, rather focusing on an economical means of production thereof. Accordingly, there would be no advantage in including a decorative pattern design on the shell of Krein, since the consumer would only see the wrapper and not any pattern on the shell."

This argument has been considered but is not deemed persuasive. It is noted that appellants appear to also agree that Kuehl provides a smooth outer surface comprising a fat based composition and decorations including a second fat based composition. In any case, it is noted that Kuehl also teach a smooth outer surface for the reasons given above with respect to Appellants' arguments on page 18 of the Appeal Brief.

As discussed above, Appellants urging that Krein is not interested in the visual appearance of his product is not deemed persuasive, especially since Krein teaches that the product is a highly attractive product. Furthermore, it is noted that the art taken as a whole teaches employing designs on the shell for the purpose of providing decoration. Appellants' urging that there would be no advantage in including a decorative pattern since the consumer would only see the wrapper is not persuasive. As discussed above, D'Amato teaches the advantages of providing a transparent container. To therefore modify the combination of Krein and D'Amato and provide designs on the fat based shell, using another fat based composition, as taught by Kuehl would therefore have been obvious for the purpose of imparting a particular aesthetic

appearance. In any case, regarding the argument that one would not see the decorative pattern, it is noted that Krein also teaches that an attractive appearance can be seen after removing the wrapper. Therefore, irrespective of the particular wrapper employed, to modify the combination and use a second fat composition to make design in the shell would have been obvious for the purpose of making a more aesthetically pleasing fat based shell.

On pages 22-23 of the Appeal Brief, Appellants urge that

"Kuehl further fails to disclose or suggest economical concerns for mass production of his ice cream bars or the use of inexpensive material. Additionally, there is no disclosure or suggestion that Kuehl's method of creating attractive visual effects on ice cream bars would even be suitable for creating such effects on fat-based shells or wafer cones."

This argument has been considered but is not deemed persuasive. It is noted that the claims are directed to a product, and as such, patentability of a product, as claimed, cannot be predicated on the particular method by which the product could be made, especially since the addition of the particular structural features would have been obvious to one having ordinary skill in the art, in view of the art taken as a whole. As discussed above, it could be conceived that the ice cream product can be pre-made and then dropped into a particular type of packaging material and then has achieved surface to surface contact by known methods such as withdrawing the air by vacuum or a water bath, for instance.

Further on page 23 of the Appeal Brief, Appellants urge that,

"Accordingly, one of ordinary skill in the art would not be motivated to combine the teachings of Kuehl and Krein. One of ordinary skill in the art would further not be motivated to combine the teachings of Kuehl and D'Amato, as Kuehl does not disclose the benefits of, or the need for packaging that protects from damage during transportation or sale. Further, Kuehl is concerned with ice cream bars and not cones as disclosed in D'Amato. Indeed Kuehl's ice cream bars would have no need for D'Amato's cone-shaped container and lid. Accordingly, Appellants reiterate that obviousness rejections may not be made by hindsight reconstruction of the art, using Appellants' disclosure as a guide, which is the only way the Examiner could have arrived at the instant obviousness rejection."

This argument has been considered but is not deemed persuasive. It is noted that Kuehl does teach packaging that closely follows the contour and volume of the product (page 3, lines 35-36). This packaging would still provide protection to the product. It is noted however that the reference to Kuehl has been relied on to teach the concept of a fat based composition used to employ designs into another fat based composition that forms the shell of the ice cream product.

It is noted that the concept of employing a fat composition for providing designs into the fat composition used to form the shell of the product has thus been taught by the art, for the purpose of providing a particular appearance to the fat based shell. In light of this, to modify the combination and employ a second fat composition to a base fat composition used to form a shell would have been obvious for its art recognized and appellants' intended function of providing a particular decoration on the fat based shell. Again it is noted that the reference to Krein already teaches a fat based confection in complete surface to surface contact with the packaging. Krein does not disclose transparent packaging or the particular designs on the fat based shell. D'Amato teaches the advantages of providing transparent packaging for ice cream products of

similar shape, and Kuehl teaches the advantages of providing designs into the fat based composition that forms the shell into which ice cream is placed. Therefore to modify the product and employ transparent packaging for viewing the product, and to further modify the product of this combination and employ the addition of decorations onto the fat based shell of Krein for providing a more aesthetically pleasing product, would have been obvious in view of the teachings of D'Amato and Kuehl.

On page 24 of the Appeal Brief, Appellants urge that

"Appellants note that while Newsteder, Palmer and Phillips all disclose methods by which to impart design or lettering onto food, none of the references disclose or suggest that the methods disclosed therein would even be suitable for imparting design or lettering to shells used in ice confectionaries."

This argument has been considered but is not deemed persuasive. It is noted that once it was recognized in the art to use a fat based composition to provide a decoration into another fat based composition that forms the shell of a product, the particular design made into the fat composition that forms the shell would have been an obvious matter of choice and/or design. In any case, Newsteder, Palmer and Phillips have been relied on to teach that it was conventional in the art to create designs onto food products that take the shape of writing, script, a logo or symbol. Since the art already teaches employing a design, the particular aesthetic pattern created would have been an obvious matter of choice and/or design.

Appellants focus on the particular methods employed by the references to Newsteder, Palmer and Phillips, however, it is noted that the claims are directed to a product and as such, to modify the product and change the design to take the shape of

writing, symbols or logos would still have been an obvious matter of choice and/or design. Whether the methods would have been suitable for designing into shells used in ice confectionaries is Appellants' opinion not supported with any convincing evidence. In any case, it is noted that appellants' arguments are not persuasive, since Kuehl already teaches methods for placing a design for a fat based shell. In summary, it is noted that there could be several methods for achieving appellants' product and as such patentability of a product, as claimed, cannot be predicated on the particular method by which the product could be made.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Viren Thakur/

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